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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,081	08/06/2003	Pramod K. Gupta	24866A	9824

28624 7590 10/03/2005

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EXAMINER	
PARA, ANNETTE H	
ART UNIT	**PAPER NUMBER**
1661	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/636,081	GUPTA ET AL.	
	Examiner	Art Unit	
	Annette H. Para	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 09/23/2003
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,8,9 are provisionally rejected over claims 17,18, 19, 20, and 21 of copending Application No. 10/405,819. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of culturing embryogenic pine tissues including Loblolly pine on medium comprising gibberellin, optionally comprising an absorbent composition as claimed in the co-pending application is the species of the genus of method comprising culturing embryogenic conifer cells; including Loblolly pine in media comprising gibberellin, and an absorbent composition as claimed in the instant application. Both applications use the absorbent composition at an overlapping range concentration. range.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18, and 20-21 are rejected under 35 U.S.C.102 (b) as being clearly anticipated by Pullman et al. (US 5,294,549 published on March, 15 1994).

The claims are drawn to a method for producing conifer somatic embryos in a medium comprising abscisic acid, gibberellin and activated charcoal as an absorbent.

Pullman et al teach a method the cultivation of somatic embryos of Douglas fir in a medium comprising gibberellin and/or abscisic acid at concentrations of 0.05 and 15 mg/L (col. 8, lines 5-6) and comprising also activated charcoal (col. 9, lines 52-54). Pullman et al. teach the medium osmolality of at least 200 mM/Kg (col.7, lines 59-61), and also teach the use of activated charcoal at a concentration of 2.5g/L (Table 2). Further Pullman et al. teach a pH of 5.7 (Table 1) and the culture of the cells for a period from 4-8 weeks (column 14, line 46). Fifty percent and 75% of the embryos taught by Pullman et al. are inherently at the same developmental stage, absent evidence to the contrary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pullman et al. (US Patent No. 5,294,549 1994)

The claim is drawn to a method of producing Loblolly pine somatic embryos in a medium comprising abscisic acid, gibberellin and activated charcoal as an absorbent.

The teachings of Pullman et al. are discussed above.

Pullman et al. do not teach using Loblolly Pine.

At the time the invention was made it would also be obvious for one of ordinary skill in the art to use the method of culturing Douglas fir to cultivate Loblolly Pine. It is noted in U.S. Patent No. 5,294,549 (col.23, lines 3-10) that those adjustments of the culture media must frequently be made depending on the particular species. In addition, this applies to the various stages of culturing and the invention has been successfully applied to several species of coniferous plants. It is also noted that the invention can be used for culturing loblolly pine (Col.7, lines 52-56).

Thus the claimed invention would have been prima facie obvious as a whole at the time it was made, if not anticipated by, the prior art, especially in the absence of evidence to the contrary.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about PAIR system, see http://pair-direct.uspto.gov . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Annette H Para

09/21/2005

ANNE KUBELIK, PH.D.
PRIMARY EXAMINER